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**REMARKS**

The Examiner is thanked for the careful review of the application as set forth in the outstanding office action. Reconsideration of the application in view of the foregoing amendments and the following discussion is respectfully requested.

**Claims Rejections - 35 USC 112, First Paragraph**

Claims 9 and 19 stand rejected as failing to comply with the enablement requirement. This rejection is respectfully traversed on the grounds that a prima facie case of non-enablement has not been established, and the application describes the subject matter of these claims in such a way as to enable one skilled in the art to make and/or use the subject matter of the these claims.

Claim 9 recites the method of Claim 1 wherein "said shifting said image includes shifting the position of the print medium along a media feed path." The specification describes, e.g. at 6:17 and FIG. 2, a media advance system including an advance roller 80, and at 11:3-6 and FIG. 8 a media drive system 90. Thus shifting the position of the print medium is described and enabled by the specification. Moreover, as the Examiner recognizes, one skilled in the art could envision several different mechanisms for achieving the task, and such acknowledgment demonstrates that the claimed subject matter has been enabled. Further, there has been no showing that one skilled in the art would be unable to make or use the claimed subject matter from applicant's specification, and thus for this reason alone the Examiner has failed to meet the burden of establishing prima facie that the subject matter of Claim 9 has not been enabled.

Similar considerations apply to the rejection of Claim 19.

The rejection under Section 112 should be withdrawn.

Claims 9 and 19 should be allowed since no other grounds of rejection have been applied against these claims.

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Claims Rejections - 35 USC 102

Claims 1-8 and 10 stand rejected as being anticipated by Mizubata et al. ("Mizubata"). This rejection is respectfully traversed on the grounds that a prima facie case of anticipation has not been established, and the applied reference does not describe each element of the claimed subject matter.

Applicant does not concede that Mizubata is prior art with respect to the subject matter of applicant's claimed subject matter of Claims 1-8 and 10. Nevertheless, the reference does not describe all elements of these claims, and thus cannot anticipate these claims.

Claim 1 is drawn to a method for printing an image on a print medium, comprising:

[A] positioning the print medium at a print zone;

[B] determining actual medium size and/or medium placement characteristics;

[C] using the size and/or placement characteristics, shifting an image to be printed relative to nominal size and/or medium placement characteristics; and

[D] printing the shifted image on the medium.

Here the letter designations A-D have been added for convenience in reference.

Mizubata does not describe at least elements B, C or D of this claim. Applicant respectfully disagrees with the Examiner's contentions as to the teachings of Mizubata. The reference describes a document reading apparatus and method for outputting an image faithful to a document even if the document is accidentally fed in an oblique fashion on a sheet feeding path. (Abstract)

Regarding [A], while the Examiner asserts that this element is described at 1:17-23 of Mizubata, this passage describes a conventional document reading apparatus, wherein a document having an image already printed thereon is fed onto a platen glass. This passage does not describe a method for printing an image on a print medium.

Regarding [B], while the Examiner asserts that this element is described at 4:45-52, this passage describes a document size detecting means for use in

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a document reading system, not a print medium size and/or medium placement characteristic determining means or system.

Regarding [C], while the Examiner asserts that this element is described at 5:16-25 and 6:4-10, applicant respectfully disagrees. These passages are involved with determining a skew quantity of the document to be read, not a step as described at C.

Regarding [D], while the Examiner asserts that this element is described at 5:16-25 and 6:4-10, applicant respectfully disagrees. These passages describe that the image read by the document reading system can be output to a display or a copying sheet, but does not describe that the characteristics or size of the copying sheet have been determined, and the image shifted relative to a nominal size of the copying sheet. Instead, Mizubata appears to assume that the copying sheet has been presented in a nominal or correct position.

Because Mizubata does not describe each element of Claim 1, the subject matter of this claim, as well as the claims depending therefrom, are not anticipated by the reference. The rejection of Claims 2-8 and 10 should also be withdrawn.

#### Claims Rejections 35 USC 103

Claims 11-18 and 20 stand rejected as being unpatentable over Mizubata in view of Muramatsu et al. ("Muramatsu"). This rejection is respectfully traversed on the grounds that a prima facie case of obviousness has not been established, and the references do not teach or suggest the claimed subject matter.

Claim 11 is drawn to a method for duplex printing an image on a print medium, comprising:

- [A] positioning a front side of the print medium at a print zone;
- [B] determining actual size and/or placement characteristics of the medium;
- [C] printing a front side image on said front side;

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[D] passing the print medium through a duplexing path to flip the print medium and present the back side of the print medium at the print zone for printing a back side image;

[E] measuring leading edge and absolute location characteristics of the flipped print medium;

[F] calculate shift parameters to shift the back side image to align with the front side image placement;

[G] print a shifted back side image.

Here the letter designations A-G have been added for convenience in reference.

Mizubata has been described above with respect to the rejection of Claims 1-8 and 10. As described above, the applicant disagrees with the Examiner's assertions of the teachings of the reference. Mizubata is concerned with reading a document, not with problems of printing an image on a print medium, and thus clearly does not disclose, for example, the limitations in paragraph B. The Examiner acknowledges that Mizubata does not disclose the limitations in paragraph D, and for this reason the reference also cannot disclose the limitations in paragraphs E-G.

Muramatsu is cited as allegedly showing "a digital copying apparatus capable of rotating original image and duplexing features (abstract and column 5, lines 25-30)." From this, the Examiner contends that Mizubata and Muramatsu are combinable because they are from the same field of endeavor this is image rotation and reproduction, and further that it would have been obvious to user a duplexer to print on both sides of paper and to repeat the same image correction procedure for the image to be printed on the back side of the paper. The Examiner alleges that the suggestion/motivation for doing so would have been to reproduce the original in the same exact layout.

The applicant respectfully disagrees with this line of reasoning, and asserts that the claimed subject matter is neither taught nor suggested by the applied references. Moreover, the line of reasoning asserted by the Examiner does not meet all claim limitations, and thus for this reason alone, a prima facie case of

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obviousness has not been established. Particularly, the limitations set out at paragraphs F and G of Claim 12 are not addressed in the office action.

Measuring a claimed invention against the standard established by 35 USC 103 requires the critical step of casting the mind back to the time of invention, to consider only the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the art. The case law of the Federal Circuit makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Evidence of a suggestion, teaching or motivation may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved. The range of sources available, however, does not diminish the requirement for actual evidence. The showing of such actual evidence must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. The required showing of evidence should include particular factual findings. In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

Here, the Examiner has made only broad, conclusory statements regarding the teachings of the references, and has asserted a broad statement of an alleged motivation to combine, i.e. to "reproduce the original in the same exact layout." Yet there is no description as to how the references provide this alleged suggestion, or indeed how the alleged suggestion would lead one to the claimed subject matter. Indeed, the alleged field of the endeavor ("image rotation and reproduction") is not supported by any citation to the record, but rather is artificially defined by the Examiner.

Muramatsu is directed to a digital copying apparatus capable of forming a binding at an appropriate position with respect to a copy image irrespective of an orientation of an orientation of an original document. The applicant respectfully submits that Muramatsu does not disclose or suggest the limitations of paragraphs F and G of Claim 12.

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The claims dependent from Claim 12 add further distinguishing features, and are also not taught or suggested by the applied references.

Because a prima facie case of obviousness has not been established, and because the applied references do not teach or suggest the claimed subject matter, the rejection under Section 103 should be withdrawn.

### CONCLUSION

The outstanding rejections have been addressed, and the application is in condition for allowance. Such favorable reconsideration is solicited.

Respectfully submitted,



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